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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

502054-A-01-US (Boyer)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on October 26, 2006

Signature

Bobbette BlakeTyped or printed
nameBobbette Blake

Application Number

10/672,633

Filed

September 26, 2003

First Named Inventor

Boyer et al.

Art Unit

2617

Examiner

Naghmeh Mehrpour

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 36,597☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Kevin M. Mason

Signature

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Typed or printed name

203-255-6560

Telephone number

October 26, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicants(s): Boyer et al.
 Case: 502054-A-01-US (Boyer)
 Serial No.: 10/672,633
 Filing Date: September 26, 2003
 10 Group: 2617
 Examiner: Naghmeh Mehrpour

I hereby certify that this paper is being deposited on this date with the U.S. Postal Service as first class mail addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Signature: *Robert B. Blair* Date: October 26, 2006

Title: Method and Apparatus for Delivering a Voice Mail Message With an Indication of the Presence of the Sender

MEMORANDUM IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
 Commissioner for Patents
 25 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

The present invention and prior art have been summarized in Applicants' prior responses.

STATEMENT OF GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 through 24 are presently pending in the above-identified patent application. Claims 1-8, 11-13, and 16-24 were rejected under 35 U.S.C. §102(e) as being anticipated by Sahai et al. (United States Patent Application Publication Number 2002/0076010 A1) and claims 9, 10, and 14-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sahai et al. in view of Haim (United States Patent Number 6,718,014).

ArgumentsIndependent Claims 1, 12 and 17

Independent claims 1, 12, and 17 were rejected under 35 U.S.C. §102(e) as being anticipated by Sahai et al. In particular, the Examiner asserts that Sahai teaches to “deliver said
 5 voice mail message to said recipient to automatically respond to the sender an indication of a presence of said sender (0028, 0041, 0056), the indication including an identification of at least one device where the sender is present (0037, 0039, 0040, 0041, 0056).” In the Response to Arguments section of the final Office Action, the Examiner asserts that Sahai teaches that “PBX
 10 110 is able to include the availability information into the message left by called party 104, and convey the modified message to called party 104 (0037), therefore any information regarding the calling party can be insert(ed) in the recipient including the identification of the at least a device where the sender is present (0037, 0039, 0040, 0041).” The Examiner also asserts that, in paragraph 0040, “in alternate of the embodiment of the invention of Sahai a query method is not used. Rather, the current likely availability of the calling party can be sent to the PBX as soon as
 15 it is known, or on a periodic basis.”

Applicants note that Sahai teaches that “the PBX modifies the voice mail message to include a statement that the calling party is either *available or unavailable*.” (Abstract; see, also, FIG. 4: steps 416 and 418; paragraph 0009; paragraph 0027; and paragraph 0039.) Sahai teaches that the “presence server senses whether the calling party has indicated his or her
 20 presence via the computer or other information device” (paragraph 0009). In the text cited by the Examiner, Sahai teaches to

[0037] note that PBX 110 has additional functionality beyond that of a commercially available PBX. As described above, PBX 110 interfaces with presence server 112. Through this interface, PBX 110 receives availability
 25 information regarding calling party 102 from presence server 112. Moreover, PBX 110 is able to include the availability information into the message left by called party 104, and convey the modified message to called party 104.

[0038] III. Method

[0039] The method of the invention, according to one embodiment, is illustrated
 30 in general in FIG. 4. The method begins with step 402. In step 404, a calling party telephones a called party. In step 406, the called party may or may not answer. If the called party answers, then the method concludes at step 422. If, however, the called party does not answer, then the method continues at step 408. In step 408, the calling party leaves a voice mail message for the called party. As discussed

above, the voice mail message is recorded physically at a PBX. In step 410, the called party subsequently accesses the calling party's message at the PBX. In step 412, the PBX queries the presence server as to whether the calling party is available for a call back from the called party. In step 414, a determination is made regarding the calling party's availability. This step will be discussed in greater detail below. If the calling party is available, then processing continues at step 416, where the message originally left by the calling party is edited to include a statement that the calling party is available. If, however, the calling party is determined not to be available in step 414, then processing continues at step 418. Here the message originally left by the calling party is edited to include a statement that the calling party is absent. At step 420, the message, edited in either of steps 416 or 418, is played to the called party. The processing concludes at step 422.

(Paragraphs 0037-0039.)

Sahai does not, however, disclose or suggest delivering said voice mail message to said recipient with an indication of a presence of a sender, said indication *including an identification of at least one device where the sender is present*. Independent claims 1 and 17 require delivering said voice mail message to said recipient with an indication of a presence of said sender, said indication *including an identification of at least one device where said sender is present*. Support for this limitation can be found in FIG. 7 and on page 12, lines 3-11 of the originally filed specification.

Regarding claim 12, Applicants note that, in the text cited by the Examiner, Sahai teaches that,

in alternative embodiments, presence server 112 is connected (via network infrastructure 114) to one or more other information devices of calling party 102, in addition to (or instead of) computer 108A. Such devices can include, for example, a telephone or PDA of calling party 102. In a manner similar to the operation described above, presence server 112 would sense whether calling party 102, using such an information device, has indicated his presence. Presence server 112 would then inform PBX 110 accordingly.

(Paragraph 0028.)

Sahai also teaches that

[0040] Note that in an alternate embodiment of the invention, a query method (e.g., step 412) is not used. Rather, the current likely availability of the calling party can be sent to the PBX as soon as it is known, or on a periodic basis. In this manner, the PBX can be automatically updated regarding the calling party's availability. The PBX can then modify a voice mail message as appropriate, without having to query the presence server.

(Paragraph 0040.)

Contrary to the Examiner's assertion, Sahai does *not* disclose or suggest delivering a voice mail message to a recipient to *automatically respond to the sender* at a device where said sender is believed to be present. Applicants could also find no disclosure or suggestion of *providing a mechanism* for a recipient to *automatically respond to a sender* at a device where the sender is believed to be present. Independent claim 12 requires providing a *mechanism for said recipient to automatically respond to said sender at a device where said sender is believed to be present*.

Thus, Sahai et al. do not disclose or suggest delivering said voice mail message to said recipient with an indication of a presence of said sender, said indication including an identification of at least one device where said sender is present, as required by independent claims 1 and 17, and do not disclose or suggest providing a mechanism for said recipient to automatically respond to said sender at a device where said sender is believed to be present, as required by independent claim 12.

Additional Cited References

Haim was also cited by the Examiner for its disclosure of a method/apparatus wherein said recipient can respond to said sender in real time. Applicants note that Haim is directed to "a system and method for improving the quality of life for telephone users by providing a real-time screening of a telephone call without the ringing of the telephone call."

(Col. 1, lines 10-13.)

Haim does not, however, disclose or suggest delivering a voice mail message to a recipient with an indication of a presence of a sender, the indication *including an identification of at least one device where the sender is present*, and does not disclose or suggest *providing a mechanism for the recipient to automatically respond to the sender at a device where the sender is believed to be present*.

Thus, Haim does not disclose or suggest delivering said voice mail message to said recipient with an indication of a presence of a sender, said indication including an identification of at least one device where the sender is present, as required by independent claims 1 and 17, and does not disclose or suggest providing a mechanism for said recipient to automatically respond to said sender at a device where said sender is believed to be present, as

required by independent claim 12.

Dependent Claims 2-11, 13-16 and 18-24

Dependent claims 2-8, 11, 13, 16, and 18-24 were rejected under 35 U.S.C. §102(e) as being anticipated by Sahai et al. and claims 9, 10, and 14-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sahai et al. in view of Haim.

Claims 2-11, 13-16, and 18-24 are dependent on claims 1, 12, and 17, respectively, and are therefore patentably distinguished over Sahai et al. and Haim (alone or in any combination) because of their dependency from independent claims 1, 12, and 17 for the reasons set forth above, as well as other elements these claims add in combination to their base claim.

All of the pending claims, i.e., claims 1 through 24, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

Respectfully submitted,



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Date: October 26, 2006